

Remarks

The drawings were objected to. New drawings are enclosed.

A check in the amount of \$18 is enclosed for the two additional claims.

Claims 1 to 20 were objected to for being numbered [c1], [c2], etc. This application was filed electronically and the Patent Office's own software automatically numbers the claims in that fashion. Applicant fails to understand why he is obligated to make corrections to a numbering format that was inserted into the application by the Patent Office itself.

Claims 1, 4, 8, 10, and 13 were rejected under 35 U.S.C. 102(b) as anticipated by Pacheco. Applicant's claims have been amended to distinguish over Pacheco. Applicant's claims now require a body having vertical sides that can be struck by a golf ball. The sides of the Pacheco device are sloped so that a golf ball does not strike the sides, but rolls up the sides. During a golf game a golfer does not put to an elevated target and this unnatural type of practice may make it difficult for a golfer to transfer his improved putting skills to a real putting green. Also, in Pacheco the balls must be hit hard enough to roll up the sides of the device and depress the pressure bars. If they are not hit hard enough to do that there is no sound, even though the ball may have been hit hard enough to have gone into a cup at the same location. That problem is

overcome in Applicant's device because a ball need only strike the device and does not have to roll up a slope before it can set off the sound. As to Applicant's Claims 13 to 20, Applicant does not agree that Pacheco discloses an on-off switch. Figure 5 shows the electrical circuit for Pacheco. There are 4 switches 6 that are closed by the pressure bars, but there is no on-off switch. That means that if you carry the Pacheco device around in your pocket, it will constantly be going off every time a pressure bar is bumped. Applicant's Claims 13 to 20 all require an on-off switch to prevent the device from making sounds when it is not being used.

Applicant's claims require a body having a head portion and a base. The base must be either a pin that can be pushed into the ground or material made of small hooks that can be releasably attached to a fabric. Pacheco discloses no such base.

Claims 2, 11, 14, and 16 were rejected under 35 U.S.C. 103(a) as being unpatentable over Pacheco in view of Lee. Pacheco has been discussed. Lee is cited to show a pin on a golf ball putting aid. The Examiner argues, "it would have been obvious to one of ordinary skill in the art to incorporate the teachings of Lee into the disclosed invention of Pacheco. Applicant does not agree. It is well settled law that if a proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA

1959). In the present case, Lee's device is radically different from the device of Pacheco. The Examiner seems to be suggesting that it would be obvious to take the pin off the bottom of Lee's aid and stick it on to the bottom of Pacheco's device, pressing the pin into ground. However, Pacheco expressly states (column 2, lines 38 to 40) that one of the objects of his invention is "to allow golfer to move target away from previously putted balls by simply sliding the target to a new location with his putter." With Lee's pin stuck into the ground this object of Pacheco's invention would no longer be possible. Therefore, it is not obvious to combine Lee with Pacheco. Applicant also notes that Lee has no way to turn off the sound of his bell, and therefore there is no on-off switch in Lee.

Claims 3, 12, 15, and 17 were rejected under 35 U.S.C. 103(a) as being unpatentable over Pacheco in view of Irving. Pacheco has been discussed. Irving was cited to show a base of material made of small hooks that can be releasably attached to a fabric. Again, the Examiner seems to be suggesting that it would be obvious to take the "Velcro" off the bottom of Irving's tee and stick it on to the bottom of Pacheco's device in order to attach Pacheco's device to a carpet. However, as Applicant pointed out hereinabove, Pacheco expressly states (column 2, lines 38 to 40) that one of the objects of his invention is "to allow golfer to move target away from previously putted balls by simply sliding the target to a new location with his putter." The "Velcro" would hold Pacheco's device to the carpet, preventing Pacheco from achieving this object of

his invention. Therefore, it is not obvious to combine Lee with Pacheco.

Claims 5 and 6 were rejected under 35 U.S.C. 103(a) as being unpatentable over Pacheco. Pacheco has already been discussed and it is believed that Applicant's amendments to Claim 1, from which Claims 5 and 6 depend, are more than adequate to distinguish over Pacheco. However, Applicant's also note that to establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). Pacheco does not disclose making the sound of a ball falling into a cup or a human voice, as the Examiner notes.

Claims 7, 9, and 18 were rejected under 35 U.S.C. 103(a) as being unpatentable over Pacheco in view of Knapp. Pacheco has been discussed. Knapp was cited to show switches that go on when a bullet strikes segments of a target. The segments are enclosed in a box and can be struck by a bullet only if the bullet is directed at the front of the box. Thus, Knapp's switches must only close when the segments are struck from the front. Applicant's sensor switch is able to close when the golf practice device is struck from any direction. In order to do that, the spring is enclosed inside a metal ferrule. As the Examiner notes, Knapp discloses no such metal ferrule with a spring

inside. Again, to establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (See citations in previous paragraph), and Knapp does not disclose the metal ferrule. Furthermore, Applicant respectfully submits that Pacheco and Knapp, as relied upon in the present rejection of the claims under 35 USC §103(a), are non-analogous references. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). In the instant case, shooting bullets at a target, as Knapp does, is not in the same field of endeavor as putting golf balls nor is it reasonably pertinent to the particular problem with which Applicant is concerned.

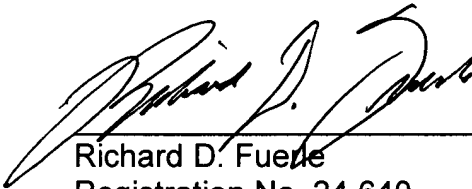
Claim 19 was rejected under 35 U.S.C. 103(a) as being unpatentable over Pacheco in view of Knapp further in view of Lee. Pacheco, Knapp, and Lee have been discussed hereinabove. Claim 19 is now represented by Claim 13, which has been amended to include additional limitations not found in these references.

Claim 20 was rejected under 35 U.S.C. 103(a) as being unpatentable over Pacheco in view of Knapp further in view of Irving. Pacheco, Knapp, and Irving have been discussed hereinabove. Claim 20 is now represented by Claim 18, which has been

amended to include additional limitations not found in these references.

All of the claims are now believed to be allowable over the references cited and reconsideration and allowance of all of the claims are therefore requested. Should the Examiner discuss the application he is invited to call Applicant's attorney at (716) 774-0091 to resolve any remaining problems.

Respectfully,

A handwritten signature in black ink, appearing to read "Richard D. Fuerle", is written over a horizontal line.

Richard D. Fuerle
Registration No. 24,640
For Applicant

Richard D. Fuerle
1711 West River Road
Grand Island, NY 14072
(716)-774-0091
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